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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/683,787	10/10/2003	Robert Kleiman	511-062	1790

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EXAMINER

PUTTLITZ, KARL J

ART UNIT	PAPER NUMBER
1621	

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/683,787	Applicant(s) KLEIMAN ET AL.	
	Examiner Karl J. Puttlitz	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413) |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/3/2006 has been entered.

The outstanding objection to claim 25 is withdrawn in view of Applicant's amendments requiring at least 2 free hydroxy groups.

Claim Objections

Claims 24, 29 and 30 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In claim 26, it is unclear what other alcohols exist besides primary secondary or tertiary alcohols, and therefore, claims 24 and 30 fail to limit claims 21 and 28, respectively.

With regard to claim 29, a fatty alcohol of claim 28 necessarily has one free hydroxyl group and therefore, this requirement in claim 29 fails to further limit claim 28.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21 and 28 recite a fatty alcohol containing starting material but the claim does not absolutely require that the starting material comprise the fatty alcohol.

Claim 24 states that the fatty alcohol composition consists essentially of a substantially pure fatty alcohol. It is unclear how the fatty alcohol composition can contain a spreading agent emollient or a botanically derived oil, as required by claim 21, but claim 21 excludes these ingredients since they would necessarily change the basic characteristics of the starting material, see MPEP 2111.03 ("The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention.").

In claim 24, it is also unclear how the fatty alcohol is substantially pure when the starting material must contain a spreading agent emollient or a botanically derived oil.

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Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

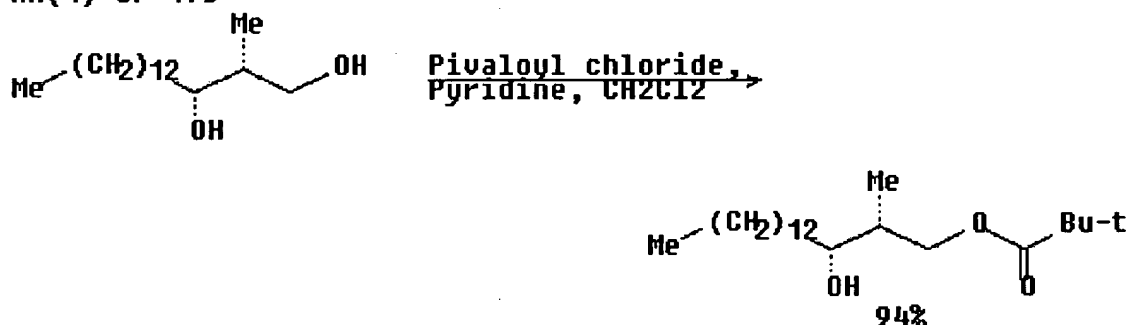
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 22 and 24-31 are rejected under 35 U.S.C. 102(b) as being anticipated or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sarabia et al. A macrolactonization approach to the stevastelins, Tetrahedron Letters, 15 April 2002, Pages 2961-2965 (Sarabia).

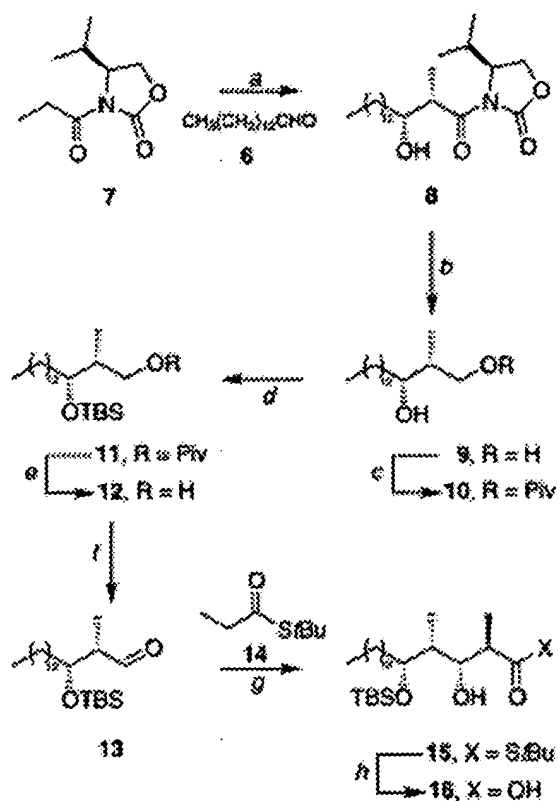
Sarabia teaches the following reaction at page 2962:

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See Scheme 1, step c:



With regard to the topical formulations in the preambles of claims 21 and 28, these are considered intended uses and are not given weight.

With regard to the presence of a spreading agent, emollient or a botanically derived oil, the specification states that "fatty compositions containing fatty alcohols

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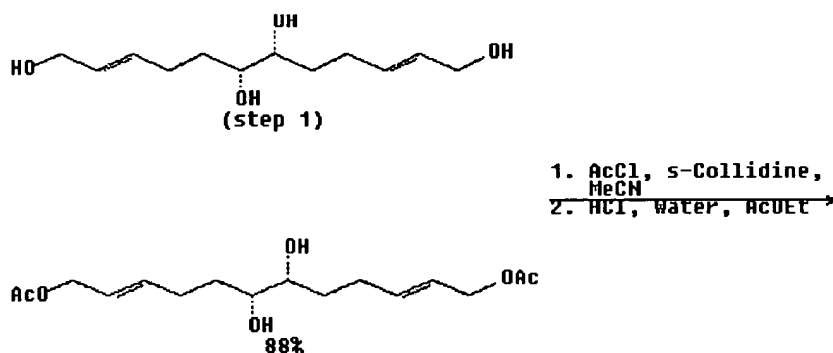
(and fatty alcohols by themselves) are common ingredients in cosmetic and personal care products. These compositions are typically used as emollients, carriers and spreading agents in pharmaceuticals, cosmetics or personal care products. [emphasis applied]", see specification at pages 4 and 5. Accordingly, given the broadest interpretation of the claim, based on the specification, the fatty alcohols in the reference are themselves a spreading agent or emollient. See M.P.E.P. 2111 ("During patent examination, the pending claims must be "given *their< broadest reasonable interpretation consistent with the specification." >*In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).< Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)").

Sarabia fails to explicitly state that the spreading properties of the fatty alcohol are increased over the spreading properties originally exhibited. However, Sarabia substantially teaches the process steps set forth in the rejected claims, and the resulting acylated product. Therefore, any physical characteristic possessed, or observed by the fatty alcohol products of the claimed invention, including spreadability, would necessarily be also possessed by the products set forth in Sarabia, or at least these characteristics would be within the motivation of those of ordinary skill.

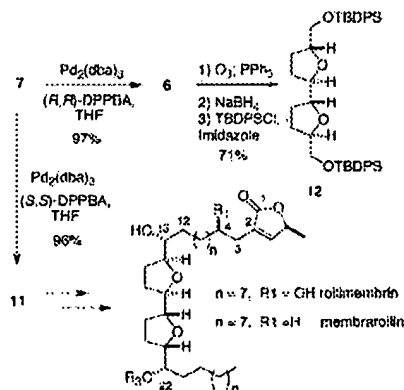
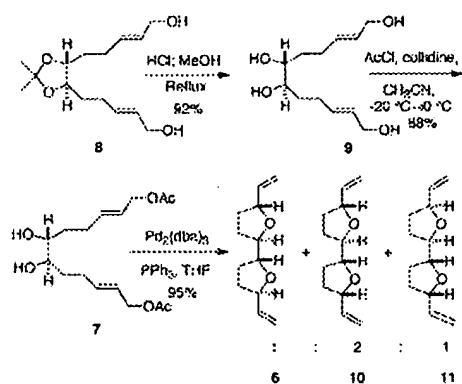
Claims 21-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Burke et al., Formal Synthesis of

Uvaricin via Palladium-Mediated Double Cyclization, *Org. Lett.*, 3 (12), 1953 -1955, 2001.

Burke teaches the following reaction at page 1954, left column:



See preparation of compound 7:



With regard to the topical formulations in the preambles of claim 21, these are considered intended uses and are not given weight.

With regard to the presence of a spreading agent, emollient or a botanically derived oil, the specification states that "fatty compositions containing fatty alcohols (and fatty alcohols by themselves) are common ingredients in cosmetic and personal care products. These compositions are typically used as emollients, carriers and spreading agents in pharmaceuticals, cosmetics or personal care products. [emphasis applied]", see specification at pages 4 and 5. Accordingly, given the broadest interpretation of the claim, based on the specification, the fatty alcohols in the reference are themselves a spreading agent or emollient. See M.P.E.P. 2111 ("During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification." >*In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).< Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)").

Burke fails to explicitly state that the spreading properties of the fatty alcohol are increased over the spreading properties originally exhibited. However, Burke substantially teaches the process steps set forth in the rejected claims, and the resulting acylated product. Therefore, any physical characteristic possessed, or observed by the

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fatty alcohol products of the claimed invention, including spreadability, would necessarily be also possessed by the products set forth in Burke, or at least these characteristics would be within the motivation of those of ordinary skill.

Claims 21-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brown et al. Journal of Organic Chemistry (1988), 53(2), 246-50, Chemical Abstracts online citation (Brown).

Brown teaches the following reaction:



With regard to the topical formulations in the preambles of claims 21 and 28, these are considered intended uses and are not given weight.

With regard to the presence of a spreading agent, emollient or a botanically derived oil, the specification states that "fatty compositions containing fatty alcohols (and fatty alcohols by themselves) are common ingredients in cosmetic and personal care products. These compositions are typically used as emollients, carriers and spreading agents in pharmaceuticals, cosmetics or personal care products. [emphasis applied]", see specification at pages 4 and 5. Accordingly, given the broadest interpretation of the claim, based on the specification, the fatty alcohols in the reference are themselves a spreading agent or emollient. See M.P.E.P. 2111 ("During patent examination, the pending claims must be "given *>their< broadest reasonable

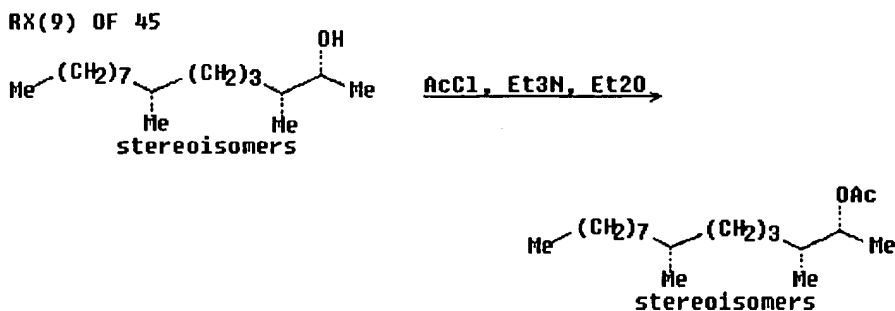
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interpretation consistent with the specification." >*In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).< Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)".

Brown fails to explicitly state that the spreading properties of the fatty alcohol are increased over the spreading properties originally exhibited. However, Brown substantially teaches the process steps set forth in the rejected claims, and the resulting acylated product. Therefore, any physical characteristic possessed, or observed by the fatty alcohol products of the claimed invention, including spreadability, would necessarily be also possessed by the products set forth in Brown, or at least these characteristics would be within the motivation of those of ordinary skill.

Claims 21-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Serebryakov et al., *Izvestiya Akademii Nauk SSSR, Seriya Khimicheskaya* (1987), (1), 114-18, Chemical Abstracts online citation (Serebryakov)

Serebryakov teaches the following reaction:



With regard to the topical formulations in the preambles of claim 21 these are considered intended uses and are not given weight.

With regard to the presence of a spreading agent, emollient or a botanically derived oil, the specification states that "fatty compositions containing fatty alcohols (and fatty alcohols by themselves) are common ingredients in cosmetic and personal care products. These compositions are typically used as emollients, carriers and spreading agents in pharmaceuticals, cosmetics or personal care products. [emphasis applied]", see specification at pages 4 and 5. Accordingly, given the broadest interpretation of the claim, based on the specification, the fatty alcohols in the reference are themselves a spreading agent or emollient. See M.P.E.P. 2111 ("During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification." >*In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).< Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)").

Serebryakov fails to explicitly state that the spreading properties of the fatty alcohol are increased over the spreading properties originally exhibited. However, Serebryakov substantially teaches the process steps set forth in the rejected claims, and the resulting acylated product. Therefore, any physical characteristic possessed, or observed by the fatty alcohol products of the claimed invention, including spreadability,

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would necessarily be also possessed by the products set forth in Serebryakov, or at least these characteristics would be within the motivation of those of ordinary skill.

Claim 21 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over SU 1432054.

SU 1432054 teaches acylation of higher fatty alcohols.

With regard to the topical formulations in the preambles of claim 21, these are considered intended uses and are not given weight.

With regard to the presence of a spreading agent, emollient or a botanically derived oil, the specification states that "fatty compositions containing fatty alcohols (and fatty alcohols by themselves) are common ingredients in cosmetic and personal care products. These compositions are typically used as emollients, carriers and spreading agents in pharmaceuticals, cosmetics or personal care products. [emphasis applied]", see specification at pages 4 and 5. Accordingly, given the broadest interpretation of the claim, based on the specification, the fatty alcohols in the reference are themselves a spreading agent or emollient. See M.P.E.P. 2111 ("During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification." >*In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).< Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)").

SU 1432054 fails to explicitly state that the spreading properties of the fatty alcohol are increased over the spreading properties originally exhibited. However, SU 1432054 substantially teaches the process steps set forth in the rejected claims, and the resulting acylated product. Therefore, any physical characteristic possessed, or observed by the fatty alcohol products of the claimed invention, including spreadability, would necessarily be also possessed by the products set forth in SU 143054, or at least these characteristics would be within the motivation of those of ordinary skill.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached at telephone number (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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